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EXAMINER

ZHOU, TING

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/007,358		ORTEGA ET AL.	
	Examiner		Art Unit	
	Ting Zhou		2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed on 10 April 2006 have been received and entered. Claims 1-9 as amended are pending in the application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "successfully" in claim 6 is a relative term which renders the claim indefinite. The term "successfully" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification has not provided any objective definition identifying a standard for determining when the process has been "successfully" performed.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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3. Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although the preamble of independent claim 1 recites a system, the remainder of the claim does not support the preamble. The “system” appears directed to software, per se, lacking any hardware to enable any functionality to be realized. Therefore, the claimed features of claim 1 is actually software, or at best, directed to an arrangement of software, and software claimed by itself without being executed or implemented on a computer medium, is non-statutory. Additionally, independent claim 1 doesn't appear to claim any executable instructions that would cause a computer to perform a practical application with a useful, concrete and tangible result and is therefore non-functional descriptive material. Claims 2-5 are rejected for the same reasons as claim 1.

4. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of the applicant amending these claims to place them within the four statutory categories of invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Pine Harbor in the article "How To Build a Shed", copyright 2000 (hereinafter "Harbor").

Referring to claims 1 and 6, Harbor teaches a system and method comprising a plurality of action glyphs representing a plurality of defined actions which are able to be undertaken by the person following the instructions (plurality of images representing steps to be undertaken in order to perform a process such as building a shed; the images include actions that are to be taken such as nailing, shown on page 5); the plurality of action glyphs including at least one of cut action glyphs and action glyph images stored on a computer (the images are displayed on and by the computer); a plurality of material glyph images representing a plurality of defined materials which are includable in the created instruction (plurality of images representing steps to be undertaken in order to perform a process such as building a shed; the images include materials such as wood, as shown on pages 4-5); the plurality of material glyph images including at least one of cut material glyph images and material glyph images stored on the computer (the images are displayed on and by the computer); and a plurality of instrumentation glyphs representing a plurality of instruments which are includable in the created instructions (plurality of images representing steps to be undertaken in order to perform a process such as building a shed; the images include instrumentations, i.e. tools such as a screwdriver, as shown on pages 5); the plurality of instrumentation glyphs including at least one of cut instrumentation glyphs and instrumentation glyph images stored on the computer (the images are displayed on and by the computer), wherein selected ones of the action glyphs, material glyphs and instrumentation glyphs are arranged in relationship to each other in accordance with a predetermined structure to form a specific instruction for performing the process irrespective of the written language

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understood by the person following the glyph instructions (the images illustrate instructions for performing the process of building a shed, as shown on pages 1-2), the glyphs being arranged either manually or by the computer (the images are arranged in a certain order on the computer screen).

Referring to claim 2, Harbor teaches the glyphs are configured with color combination, which provides visual distinction between the glyphs (the images are displayed on a colored computer screen).

Referring to claim 3, Harbor teaches when the instruction is viewed from left to right, the predetermined structure requires at least one of the action glyphs to be placed as the initial glyph, at least one of the material glyphs to be placed following the at least one action glyph, and at least one of the instrument glyphs to be placed following the at least one material glyph (the images are displayed from left to right; since each image shows actions, materials and instrumentations, the images are displayed with the action glyph first, then material glyph and lastly the instrument glyph) (pages 1-2).

Referring to claim 4, Harbor teaches the predetermined structure creates a scenario (the images represent an executable process for the user to carry out) (pages 1-2).

Referring to claim 5, Harbor teaches wherein the instructions are directed to a manufacturing process performed by the person following the glyph instructions and not by the computer (instructions for allowing users to perform the process of building a shed) (pages 1-2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pine Harbor in the article "How To Build a Shed", copyright 2000 (hereinafter "Harbor") and Ballard U.S. Patent 6,321,243.

Referring to claim 7, Harbor teaches a system comprising a plurality of action glyphs representing a plurality of defined actions which are able to be undertaken by the person following the instructions (plurality of images representing steps to be undertaken in order to perform a process such as building a shed; the images include actions that are to be taken such as nailing, shown on page 5); a plurality of material glyph images representing a plurality of defined materials which are includable in the created instruction (plurality of images representing steps to be undertaken in order to perform a process such as building a shed; the images include materials such as wood, as shown on pages 4-5); a plurality of instrumentation glyphs representing a plurality of instruments which are includable in the created instructions (plurality of images representing steps to be undertaken in order to perform a process such as building a shed; the images include instrumentations, i.e. tools such as a screwdriver, as shown on pages 5); a glyph instruction generating system having an electronic storage element which stores electronic images of the action glyphs, the material glyphs and the instrumentation glyphs (the images are displayed on and by the computer) and an output device which outputs hardcopy

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images of the selected glyphs in relationship to each other in accordance with a predetermined structure to represent the inputted instructions (the images are displayed on the computer screen in a sequence in order to illustrate instructions for performing the process of building a shed, as shown on pages 1-2). However, Baker fails to explicitly teach an input device by which a user selects a language and enters instructions in the selected language, and a translator configured to receive the inputted instructions and to interpret the inputted instructions so as to select the glyphs, which represent the inputted instructions. Ballard teaches a system for creating and displaying glyph images (Ballard: column 2, lines 35-41) similar to that of Harbor. In addition, Ballard further teaches a glyph instruction generating system comprising an electronic storage element (Ballard: column 4, lines 51-53 and column 5, lines 6-9), input device by which users selects a language and enters instructions in the selected language (the users enter characters in a certain language that are to be converted into glyph images) (Ballard: column 5, lines 9-14), a translator configured to receive the inputted instructions and to interpret the inputted instructions so as to select the glyphs which represent the inputted instructions (convert the inputted instructions, or text to glyphs) (Ballard: column 1, lines 26-33, column 3, lines 35-41 and column 7, lines 19-23), and an output device for displaying the selected glyphs (Ballard: column 5, lines 18-22). It would have been obvious to one of ordinary skill in the art, having the teachings of Harbor and Ballard before him at the time the invention was made, to modify the system interface for creating and displaying instructions via images of Harbor to include the translator for converting input text to glyphs, taught by Ballard. One would have been motivated to make such a combination in order to cross the language barrier and create information that everyone can understand, regardless of nationality and literacy.



Referring to claim 8, Harbor, as modified, teach wherein the input device presents a plurality of languages in which to enter instructions (a plurality of language systems such as English, German, French, etc. in which characters, or scripts can be entered to be used to convert to glyphs) (Ballard: column 5, lines 53-67 through column 6, lines 1-4).

Referring to claim 9, Baker, as modified, teach the user is guided through a process for generating instructions (user is guided in the selection of symbols by differentiating valid symbols that the user can choose from to create the instruction from the invalid symbols) (Baker: age 7, paragraphs 0065-0067).

### ***Response to Arguments***

7. Applicant's arguments filed 10 April 2006, regarding the 101 rejections of claims 1-5 have been fully considered but they are not persuasive. The examiner respectfully argues that the claims still appear to be reasonably interpreted as system of non-functional descriptive material, per se. This is partly due to the manner in which the amended material was written. Because of the combination of "at least one of" and the position of the "stored on a computer," it appears that the first of each of the items listed as "at least one of" need not be stored on a computer. Even assuming for arguments sake that this is somehow functional descriptive material and the claims does somehow mandate inclusion of the computer within the system, there would still be an issue in that it appears to contain the judicial exception of an abstract idea and not be directed to a system for implementing a practical application of that idea. Instead of functional descriptive material being present in the system that would produce a useful, concrete and tangible result when executed, the system itself appears to be a collection of non-functional descriptive

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material. It is noted that the "wherein" clause indicates an intent to have the glyphs arranged to form an instruction, but the system fails to include a mechanism for arranging them in such a manner that would produce a useful, concrete and tangible result. The preamble indicates that the arrangement will be "understandable by a person." It does not appear that what is claimed would provide assured, repeatable (i.e., concrete) results for accomplishing this statement.

Likewise, what useful and tangible result is produced if the person cannot follow the glyphs?

Therefore, the examiner respectfully maintains that claims 1-5 are non-statutory.

8. Applicant's arguments with respect to the 102 and 103 rejections of claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

9. With respect to the 112 rejection of claim 6, the examiner respectfully points out that the applicants do not necessarily need to include the word "successfully" in the amended claim language to overcome the previous 112, second paragraph rejection regarding the term "understandable". The term "successfully" is vague and indefinite, absent an explicit standard for determining when the process has been "successfully" performed in the specification.

10. With regards to claim 7, the applicant's arguments have been fully considered but they are not persuasive. The applicant argues that it would be extremely difficult, if not impossible, to create "instructions understandable by a person following the instructions to perform a process, irrespective of which written language is understood by the person following the instructions" utilizing the glyphs of Ballard. However, the examiner respectfully notes that the

body of the claim language does not recite the limitation of “instructions understandable by a person following the instructions to perform a process, irrespective of which written language is understood by the person following the instructions”. In response to applicant's arguments, the recitation “creating pictographic instructions understandable by a person following the instructions to perform a process, irrespective of which written language is understood by the person following the instructions” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The claim language simply recites that the user selects a language and enters instructions in the selected language. Ballard teaches the users entering an input text; since the user enters a text run, there is an inherent selection of a language, i.e. the language of the text that was input.

11. The examiner further notes that elements claimed with the use of the language “includable” (i.e. “a plurality of material glyphs representing a plurality of defined materials which are includable in the created instructions” and “a plurality of instrumentation glyphs representing a plurality of instruments which are includable in the created instructions”) are not necessarily included. Although the examiner has addressed these limitations in the art rejection, the examiner respectfully points out that material and instrumentation glyphs are *capable of* being included in the instruction, they do not *have to* be included.

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ

A handwritten signature in black ink, appearing to read 'Kieu D. Vu', with a stylized flourish at the end.

**KIEU D. VU**  
**PRIMARY EXAMINER**